

Remarks

I. Summary of the Office Action

In the Office Action mailed September 28, 2009, the Office required election of one of Figures 1-6 and Figure 7. Applicants elect Figures 1-6 and corresponding claims 1, 2, 4-13. Accordingly, claim 14 is withdrawn.

The Office objected to claims 1 and 7 due to misspelled terms. Applicants thank the Examiner for noting these typographical errors. Claim 1 has been amended to recite “reducible” in place of “reduceable” and claim 7 has been amended to recite “portions” rather than “positions.”

The Office also rejected claim 1 under 35 U.S.C. § 112, 2nd ¶ because it is allegedly unclear what is meant by “the implant forming in a first state an elongated article extending along a longitudinal axis.” Likewise, claims 10 and 11 were rejected because it is allegedly unclear what is meant by the occluding bodies having “in the first state a compressed form.” In addition, the Office rejected claims 1, 2, 9, and 13 under 35 U.S.C. § 102(b) as allegedly being anticipated by Freudenthal (WO 01/49785), while claim 12 was rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Freudenthal in view of Solymar (US 6,488,706).

The Examiner indicated that claims 3-8 would be allowable if rewritten in independent format. Claims 1-2 and 4-13 are currently pending in the application. Of these claims, claim 1 is in independent format, and the rest are in dependent format. Applicants submit that the claims, as they stand, distinguish over the cited art.

II. Status of the Claims

Applicants do not agree with the Office’s reasons for rejecting the claims. However, Applicants have amended claim 1 in this pending application to incorporate the limitation of

claim 3, as the Examiner suggested. As such, claim 3 has been cancelled. Similarly, claims 4-8 have been amended to depend from claim 1. The claim amendments are made without prejudice and in an effort to expedite the pending claims to allowance. Applicant reserves the right to pursue the subject matter of any previously pending claim(s) in a related continuing application.

Applicant also amended claim 9 to correct the omission of the word “claim.” Claims 1, 2 and 9-12 have been further amended to recite one second occluding body in place of “at least one second occluding body.”

Applicant has added dependent claim 15, which recites that “the elongate members comprise thickened portions arranged on both sides of the first occluding body and the at least one second occluding body.” Applicant also added dependent claim 16, which recites that “the first and second holders comprise a locking mechanism.” These new claims find support in the specification’s paragraphs [0028] and [0038], respectively.

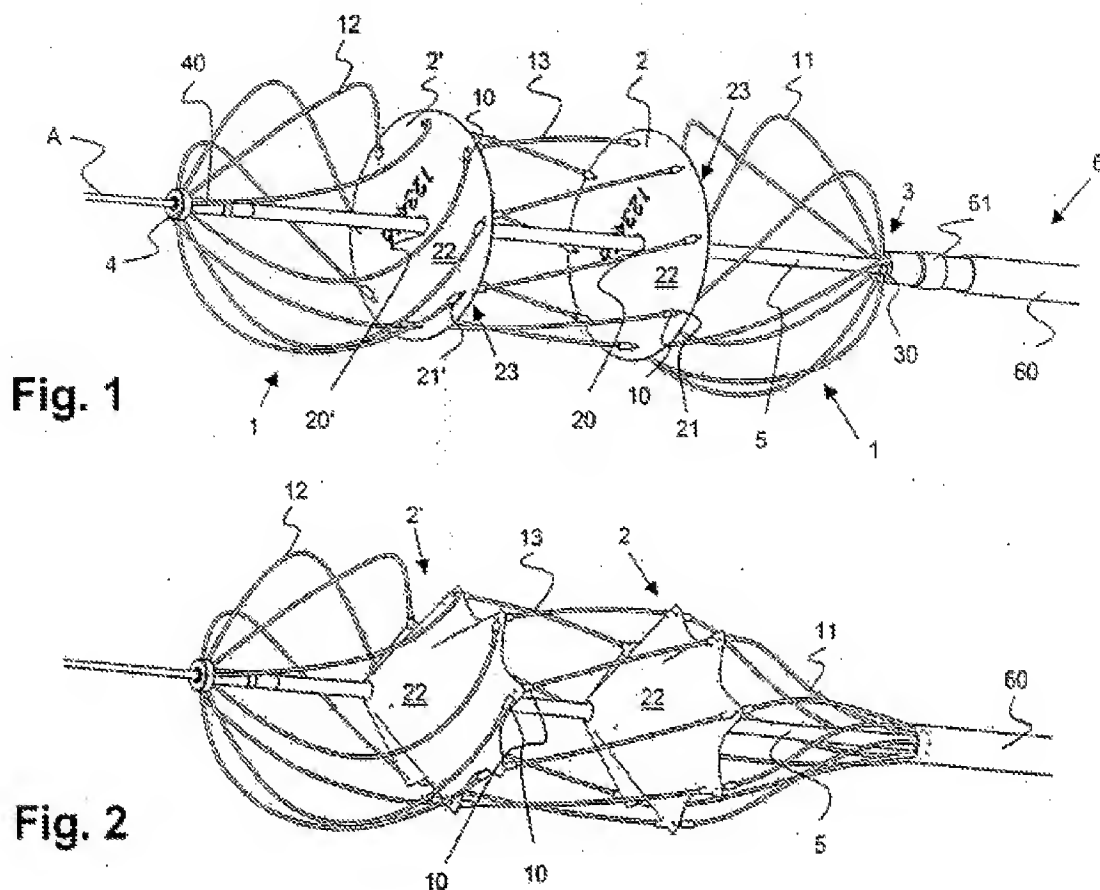
No new matter has been added by these amendments.

Lastly, it is requested that withdrawn claim 14 be reinstated and allowed. Claim 1 is generic, and claim 14 depends therefrom.

III. Response to Rejection Under 35 U.S.C. § 112, 2nd

The Office alleged that it is unclear what is meant in claim 1 by “the implant forming in a first state an elongated article extending along a longitudinal axis.” The Office then states that “it was read as meaning the implant forms an elongated article (or an elongated structure), which extends along a longitudinal axis.” The Office’s own interpretation of the term actually evidences the clarity of this limitation. Further, Figure 2 (shown below) and paragraphs [0026] and [0033-34] of the published application provide clear support for this limitation, specifically stating that “[t]he implant extends along a virtual longitudinal axis A.” As such, Applicant

asserts that the language is clear as currently employed.



The Office also alleged that “it is unclear what is meant by the occluding bodies having a compressed form in the first state within claim 10” and that “the occluding bodies having an extended or compressed form is not disclosed.” Applicants direct the Examiner’s attention to paragraphs [0032] and [0034], which state that “[s]ince [the occluding bodies] are made of flexible material, they can be compressed into a compressed form, for example being similar to an umbrella.” Further, compare the implant in Figures 1 and 2. Figure 1 shows the implant in the “initial state” prior to being compressed, and Figure 2 shows the implant “partly compressed by the sleeve.” *Published Application*, ¶¶ [0025, 0033]. The application further clarifies that “[c]ompressing the implant causes the occluding bodies 2, 2’ to reduce their outer cross-section or diameter.” *Id.* at ¶ [0033]. Accordingly, Applicants respectfully submit that the term

“compressed form” is definite.

IV. Response to Rejection Under 35 U.S.C. § 102(b)

Claim 1, 2, 9, and 13 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Freudenthal (WO 01/49785). According to MPEP § 2131, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.’ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . . The identical invention must be shown in as complete detail as is contained in the . . . claim.’ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).”

Applicant submits that the rejection has been overcome by the amendment to independent claim 1 incorporating the limitation of claim 3, which the Examiner indicated contained allowable subject matter. *See Office Action*, p. 7. As all the other pending claims under examination are dependent upon Claim 1, those claims are also not anticipated. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection based on 35 U.S.C. § 102(b).

V. Response to Rejection Under 35 U.S.C. § 103(a)

Claim 12 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Freudenthal in view of Solymar (US 6,488,706). Claim 12 is dependent on newly amended claim 1, which contains subject matter that the Examiner has indicated is allowable. As such, Applicant submits that the deficiencies in the Freudenthal reference are not cured by the teachings of the Solymar reference. And since new claim 15 is dependent on claim 12 it likewise is not rendered obvious. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a).

VI. Conclusion

In view of the foregoing, Applicant submits that all of the pending claims, as well as the alternate species claim 14, are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all the claims (1, 2, 4-16). If the Examiner would like to discuss any aspect of this case, the Examiner is invited to telephone the undersigned at 312-913-0001.

Further, if any underpayment or overpayment of fees exists, the Commissioner is hereby authorized to accordingly credit or charge Deposit Account No. **13-2490**.

Respectfully submitted,

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